



MS APPEAL BRIEF
PATENT
0879-0230P

IN THE U.S. PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Atsushi MISAWA

APPEAL NO.:

APPL. NO.: 09/286,906

GROUP: 2612

FILED: April 6, 1999

EXAMINER: Luong Trung NGUYEN

FOR: CAMERA WITH MONITOR

APPEAL BRIEF

TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST	1
II.	RELATED APPEALS AND INTERFERENCES	2
III.	STATUS OF CLAIMS	2
IV.	STATUS OF AMENDMENTS	2
V.	SUMMARY OF THE CLAIMED SUBJECT MATTER	2
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	6
VII.	ARGUMENTS.....	6
A.	Claims 1 and 14	7
1.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Claims 1 and 14	7
a.	Argument Summary	7
b.	Legal Requirements of <i>Prima Facie</i> Anticipation.....	7
c.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Independent Claim 1	8
d.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Dependent Claim 14.....	11
B.	Claims 2-4, 13, and 15-27	13
1.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Claims 2-4, 13 and 15-27	13
a.	Argument Summary	13
b.	Legal Requirements of <i>Prima Facie</i> Obviousness.....	13
2.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claims 2 and 18.....	14
a.	Cited References Fail to Teach or Suggest All of the Claimed Elements	16
b.	The Rejection Fails to Provide Proper Motivation For Combining the Teachings of the Cited References	17
c.	The Rejection of Dependent Claims 2 and 18 Relies On Impermissible Hindsight Reasoning	18
3.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 3.....	18
4.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 4.....	19
5.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 13.....	21

6.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claims 15 and 20.....	22
7.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 16.....	24
8.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 17.....	25
9.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Independent Claim 21.....	26
10.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 22.....	28
11.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claims 23, 24, and 25.....	29
12.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claims 26 and 27.....	30
C.	Claims 6-8 and 12.....	30
1.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 6.....	31
2.	The Rejection Fails to Establish <i>Prima facie</i> Obviousness of Dependent Claims 7, 8, and 12.....	32
D.	Claim 9.....	33
1.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 9.....	33
VIII.	CONCLUSION	34
IX.	CLAIMS APPENDIX.....	A-1
X.	EVIDENCE APPENDIX.....	A-9
XI.	RELATED PROCEEDINGS APPENDIX	A-9

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APPEAL BRIEF ON BEHALF OF APPELLANT: Atsushi Misawa

MS APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 3, 2005

Sir:

This appeal is from the decision of the Examiner dated November 3, 2004, finally rejecting claims 1-4, 6-9, and 12-27, which are reproduced as an Appendix to this Brief.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this paper and to credit any overpayment to Deposit Account No. 02-2448.

I. REAL PARTY IN INTEREST

The real party in interest for this application is the Assignee, Fuji Photo Film Co., Ltd., No. 210, Nakanuma, Minami-Ashigara-Shi, Kanagawa, Japan.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claim 1-27 are currently pending in this application. Claims 1-4, 6-9, and 12-27 are rejected and the subject of the present appeal. Claims 5 and 10-11 contain allowable subject matter. Claims 1, 10, and 21 are independent.

IV. STATUS OF AMENDMENTS

No amendments have been presented after the Final Rejection of November 3, 2004.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention is a camera with a monitor which enables the reproducing of a dynamic image on a large screen that makes it possible to confirm the entire image at the time of recording since the hand holding the camera does not cover and hide the image. The camera includes an imaging part 12 for capturing an image of a subject; a selector 26 for selecting one of a recording mode and a reproducing mode; and a recording part 36 for recording the image captured by the imaging part on a recording medium upon receiving a command to record in the

recording mode. The camera further includes a reproducing part 34 for reproducing an image from the recording medium in the reproducing mode (page 5, lines 20-26); and a monitor 30 for displaying an image. The camera further includes a display controller 42 for controlling the monitor to display the image captured by the imaging part on a first area on a monitor in the recording mode and to display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode, the first area being smaller than the second area (page 6, line 25 through page 7, line 6; page 7, line 28 through page 8, line 5).

The camera further includes a grip 18 to be held by a hand of an operator in the recording mode, the grip being arranged at front of a body of the camera (Figure 1), wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite the grip (Figure 2). The monitor is further arranged such that a part of the second area and none of the first area are covered with the hand of the operator holding the camera by the grip in the recording mode (Figure 4).

The camera further includes a touch panel 32 arranged over the monitor, wherein an operational button 50, 52 is displayed on an area other than the first area on the monitor in the recording mode, so that the monitor and the touch panel serve as a camera operation part. The operation button comprises at least one of a zoom operation button and an exposure correcting button (page 7, lines 11-14). Additionally, at least one operational button may be provided for instructing the image reproduced on the monitor to be switched on a frame-by-frame basis in an order, an operational button for instructing the image reproduced on the monitor to be switched

on a frame-by-frame basis in a reverse order, an operational button for instructing the image reproduced on the monitor to be enlarged, and an operational button for instructing the image reproduced on the monitor to be reduced as displayed on the monitor in the reproducing mode (page 8, lines 19-28).

The camera further provides for a first area on the monitor being arranged to exclude an area covered with the hand of an operator holding a body of the camera to operate the camera to record the image (Figure 4). The display further includes a third area, wherein the third area is a marginal area on the display in which no image data appears and thereby provides a gripping area for the operator during the recording mode (Figures 4-5).

The display controller may further be configured to change a size of an image displayed on the monitor in accordance with switching between the recording mode and reproducing mode by the mode selector (page 9, lines 5-6).

Further, a back grip part at a side of the back of the camera which is held by a hand of the operator is made as a part of the display of the monitor, wherein the hand of the operator, during the recording mode, grips a part of the monitor (Figure 4).

The camera during the recording mode does not display the captured image or the preview image on a part of the monitor which corresponds to the back grip part, the part of the display of the monitor that is covered by the operator's hand (Figure 4).

The camera further provides wherein one of a strobe 23 and a lens 14 provided at the front face of the camera is covered by a hand of the operator to hold the camera in the

reproducing mode, whereby gripping the back of the camera can be avoided and a reproduced image is displayed on a portion corresponding to a gripping portion of the monitor (Figure 6).

The monitor of the camera is further arranged at a back of a body of the camera, wherein a hand of the operator holding the camera extends to a portion of the monitor to cover the monitor by the hand of the operator in order to hold the camera for taking pictures (Figure 4).

The camera further has a release button 20 on the top face of the body of the camera, wherein the monitor, at the back of the body of the camera extends to have a width which extends to at least interfere or cross over a line which is drawn vertically from the bottom of the release button to the bottom of the camera (Figure 1). The camera further provides for a back grip part at a side of the back of the camera which is held by a hand of the operator and is made as a part of the display of the monitor, wherein a part of the monitor is covered by the base of the thumb of the operator gripping the camera in the recording mode and wherein at least one of a captured image or a preview image is displayed on a part of the monitor which is uncovered by the base of the thumb of the operator (Figure 4).

The monitor further displays the entirety of the image on the first area in the recording mode and the entire area of the image on the second area in the reproducing mode (Figures 4 and 6, respectively). The display controller of the camera further displays only the image captured by the imaging part on the monitor on the recording mode and displays only the image reproduced from the recording medium on the monitor in the reproducing mode (page 4, line 25 through page 5, line 1).

The summary of the claimed invention herein is being made to comply with the Patent Office Rules in submitting Briefs and is not to be considered as limiting the claimed invention.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Final Office Action provides four (4) grounds of rejection for review on appeal.

- 1) Claims 1 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Oku et al.* (JP 01-320871) (hereinafter “*Oku et al.*”);
- 2) Claims 2-4, 13 and 15-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oku et al.* in view of *Okada* (USP 5,515,104) (hereinafter “*Okada*”);
- 3) Claims 6-8 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oku et al.* in view of *Kawamura et al.* (U. S. Patent Application Publication No. 2002/0008763) (hereinafter “*Kawamura et al.*”); and
- 4) Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oku et al.* in view of *Furuya* (USP 4,977,456) (hereinafter “*Furuya*”).

VII. ARGUMENTS

Appellant will demonstrate that the claims are all distinguishable from the cited prior art of record.

A. Claims 1 and 14

1. The Rejection Fails to Establish *Prima Facie* Anticipation of Claims 1 and 14

a. Argument Summary

The reasoning provided in support of the rejection of claims 1 and 14 under 35 U.S.C. § 102(b) as being anticipated by *Oku et al.* fails to establish *prima facie* anticipation. Generally, the deficiencies of the rejection are that the rejection attributes certain claimed features to *Oku et al.* that a detailed reading of the reveals are not taught therein. These deficiencies exist for the rejection of each of claim 1 and 14.

b. Legal Requirements of *Prima Facie* Anticipation

In order to properly anticipate Appellant's claimed invention under 35 U.S.C. § 102(b), each and every element of the claim in issue must be found, either expressly described or under the principles of inherency, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). Finally, the elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

c. **The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 1**

Independent claim 1 is directed to a camera comprising an imaging part for capturing an image of a subject and a selector for selecting one of a recording mode and a reproducing mode. The camera further comprises a recording part for recording the image captured by the imaging part on a recording medium upon receiving a command to record in the recording mode; and a reproducing part for reproducing an image from the recording medium in the reproducing mode. The camera further includes a monitor for displaying an image and a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in a recording mode and the display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode, the first area being smaller than the second area.

In maintaining his rejection of independent claim 1, the Examiner asserts in Paper No. 20, page 5, paragraph 6, that *Oku et al.* teaches:

a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode, and the display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode, the first are[a] being smaller than the second area (Oku et al. disclose that the display of the live recording image (by CAM) and the display of the reproduced image (by VTR) are displayed on electronic viewfinder (figure 1), and the display of the live recording image (by CAM) is displayed in the central part of figure 7c which is smaller than the display of the reproduced image (by VTR), see figure 7c, page 8, line 9-13).

Appellant disagrees that *Oku et al.* disclose a selector for selecting one of a recording mode and a reproducing mode; and a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode, and to display the image reproduced from the recording mode on a second area on the monitor in the reproducing mode, the first area being smaller than the second area.

The disclosure of *Oku et al.* is directed to a monitor device for a video tape recorder. *Oku et al.* seek to solve the problem of prior monitor devices by providing a recording mode and a playback mode to be overlapped by allowing a user to check a picture to see if proper recording on the video tape recorder (VTR) is occurring during the recording mode (Oku Translation, page 3, lines 17-25).

As disclosed in Figure 1, the device includes electronic viewfinder 1, operation part 3, and switch 5 for selecting a picture projected on the electronic viewfinder 1. A pick-up picture is converted into picture signals CV (camera video) and RV (record video) of prescribed formats, picture signal CV is sent to an input terminal provided on one side of switch 5 and picture signal RV is output as a recording signal VTR 4 (page 4, lines 24-30).

Operation part 3 has two mode switches 31a and 31b. 31a is a record mode switch and 31b is a check mode switch. As can be seen in Figure 3, when record mode switch 31a is pressed at point I, picture signal CV from the video camera is selected and projected on the electronic viewfinder 1. Period III indicates a situation in which check mode switch 31b is pressed while in

the recording status. During the period, picture signal PV is a playback signal used for simultaneous playback during the recording (page 5, lines 14-16; lines 23-26; and lines 31-35).

In a fourth embodiment, *Oku et al.* discloses composing signal CV from video camera 2 and signal PV from VTR 4 within the same screen. Logic circuit 7 transmits the gate pulse to switch 5 during the aforementioned simultaneous monitoring period (3 in Figure 3) in order to project the composite picture on electronic viewfinder 1. An example composite picture screen is shown in Figure 7. In Figure 7(c), the center part is used for the picture from the video camera and the peripheral part is used for the picture from the VTR. The video camera picture and the VTR playback picture can be checked simultaneously at all times even during the simultaneous monitoring period so that even more effective simultaneous monitoring can be achieved (page 8, lines 1-16).

As noted above, in support of his rejection of claim 1, the Examiner relies on a recording mode set by switch 31a and a playback mode set by switch 5. The Examiner further asserts that Figure 7(c) discloses the display of the live recording image by CAM being smaller than the display of the reproduced image by BTR.

First, Appellant respectfully submits that *Oku et al.* fails to disclose a selector for selecting one of the recording mode and a reproducing mode. While record mode 31a may teach or suggest a recording mode, check mode 31b teaches a recording mode **and** a reproducing mode incorporated in one mode. As such, Appellant maintains that *Oku et al.* fails to teach or suggest a selector for selecting one of a recording mode and a reproducing mode.

Further, Appellant maintains that *Oku et al.* fails to teach or suggest a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in a recording mode and to display the image reproduced from the recording medium on a second area on the monitor in a reproducing mode, the first area being smaller than the second area. *Oku et al.* clearly teaches that the composite picture screen shown in Figure 7(c) is during the check mode where the recording and the reproducing signals are displayed simultaneously. However, there is no teaching or suggestion in *Oku et al.* that is directed to, during recording mode 31a, controlling the monitor to display the image captured by the imaging part on a first area on the monitor, the first area being smaller than the second area. *Oku et al.* clearly teach during the recording mode that the image is displayed on the full display.

As *Oku et al.* fail to teach or suggest all of the elements of the claimed invention, Appellant maintains that *Oku et al.* fail to anticipate the present invention. By failing to provide a reference that teaches or suggests all of the claimed elements, Appellant maintains that the Examiner has failed to establish *prima facie* anticipation under 35 U.S.C. § 102.

d. The Rejection Fails to Establish *Prima Facie* Anticipation of Dependent Claim 14

Claim 14 depends directly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 102(b) based on *Oku et al.* fails to establish *prima facie* anticipation for dependent claim 14 for at least the reasons set forth above regarding claim 1. Appellant further submits that dependent claim 14 is separately patentable and offers the following additional argument for the invention of claim 14.

The invention of claim 14 provides for a display controller that changes a size of an image displayed on the monitor in accordance with the switching between the recording mode and the reproducing mode by the mode selector.

In support of his rejection of claim 14, the Examiner asserts in Paper No. 20, page 5, paragraph 6, that Oku et al discloses:

the display controller changes a size of an image displayed on the monitor in accordance with switching between the recording mode and the reproducing mode (figure 7c).

Appellant disagrees that *Oku et al.* disclose the display controller changing a size of an image displayed on the monitor in accordance with switching between the recording mode and the reproducing mode, as set forth in dependent claim 14.

As noted above with regard to claim 1, *Oku et al.* fail to disclose a recording mode and a reproducing mode. Based upon this deficiency, *Oku et al.* clearly fail to teach or suggest changing a size of an image displayed on the monitor in accordance with the switching between the recording mode and the reproducing mode. As the Examiner has failed to provide references that teach or suggest all of the claimed elements, the Examiner has failed to establish *prima facie* anticipation under 35 U.S.C. § 102. As such, Appellant maintains that dependent claim 14 is allowable over *Oku et al.*

B. Claims 2-4, 13, and 15-27

1. The Rejection Fails to Establish *Prima Facie* Obviousness of Claims 2-4, 13 and 15-27

a. Argument Summary

The reasoning provided in support of the rejection of claims 2-4, 13 and 15-27 under 35 U.S.C. § 103(a) as being unpatentable over *Oku et al.* in view of *Okada* fails to establish *prima facie* obviousness. Generally, the deficiencies of the rejection are that:

- a) the rejection attributes certain claimed features to the references that a detailed reading of the references reveals are not taught therein;
- b) when the nature and purpose of the device of *Oku et al.* is recognized, it is evident that there is no suggestion or motivation in either of the references cited in support of the rejection or in knowledge generally available to those skilled in the art to modify *Oku et al.* in a manner asserted by the rejection; and
- c) by asserting that certain modifications to the device of *Oku et al.* would have been obvious without a proper suggestion or motivation in the applied references or elsewhere to make the asserted modifications, the rejection appears to rely on impermissible hindsight reasoning.

Such deficiencies exist for the rejection for each of claims 2-4, 13, and 15-27.

b. Legal Requirements of *Prima Facie* Obviousness

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of the prior art must be supported by

some teaching, suggestion, or motivation in the applied references or in knowledge generally available to one skilled in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-909, 200 USPQ 504, 510 (C.C.P.A. 1979).

The teaching or suggestion to make the asserted combination or modification of the primary reference must be found in the prior art and cannot be gleaned from applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In other words, the use of hindsight to reconstruct the claimed invention is impermissible. *Uniroyal Inc. v. Rudlan-Wiley Corp.*, 5 USPQ 1434 (Fed. Cir. 1983).

Finally, when considering the differences between the primary reference and the claimed invention, the question for assessing obviousness is not whether the differences themselves would be been obvious, but instead whether the claimed invention as a whole would have been obvious. *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

2. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 2 and 18

Claims 2 and 18 depend directly from claim 1. Appellant submits that claims 2 and 18 are allowable for the reasons set forth with regard to claim 1 at least based upon their dependency on

claim 1. Appellant further submits that dependent claims 2 and 18 are separately patentable and offers the following additional arguments for the inventions of claims 2 and 18.

The invention of claim 2 provides for a camera including a grip to be held by a hand of an operator in the recording mode, the grip being arranged at a front of a body of the camera, wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip. Claim 18 similarly recites wherein the monitor is arranged at the back of a body of the camera wherein a hand of the operator holding the camera extends to a portion of the monitor to cover the monitor by the hand of the operator in order to hold the camera for taking pictures.

In support of his rejection of claim 2, the Examiner asserts in Paper No. 20, page 6, paragraph 8, as follows:

Oku et al. fail to specifically disclose a grip to be held by a hand of an operator in the recording mode, the grip being arranged at affront of a body of the camera; wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip. However, Okada discloses a camera has a grip (figure 1) and monitor (LCD 15) is arranged at a back of the body of the camera and extends to a part opposite to the grip (figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Oku et al. by the teaching of Okada in order to let the operator hold the camera easier when taking picture and viewing picture at the same time.

Appellant disagrees that *Okada* discloses the monitor being arranged at a back of the body of the camera and extending to a part opposite to the grip, as set forth in dependent claim 2.

Appellant further disagrees that the teaching of *Okada* are properly combinable with the teachings of *Oku et al.* to render dependent claim 2 obvious.

a. **Cited References Fail to Teach or Suggest All of the Claimed Elements**

The disclosure of *Okada* is directed to a camera having color correction coefficient set in accordance with a combination of photographic parameters. As can be seen in Figure 1, the grip of the camera is depicted at the leftmost portion of the camera. As can be seen in Figure 2, LCD 15 is mounted on the rear cover of 14 at a point where a camera operator holding the grip of the camera would not interfere with the display of LCD 15.

The Examiner asserts that *Okada* discloses a monitor extending to a part opposite the grip citing to Figure 2. However, it is clearly shown in Figure 2 that the monitor is arranged such that the hand of the operator holding the grip would not interfere with the monitor. As such, Appellant maintains that *Okada* fails to cure the deficiencies of the teachings of *Oku et al.*, assuming these references are combinable, which Appellant does not admit. Similarly, *Okada* fails to teach or suggest wherein the hands of the operator holding the camera extends to a portion of the monitor to cover the monitor in order to hold the camera for taking pictures.

As the Examiner has failed to provide references that teach or suggest all of the claimed elements, Appellant maintains the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103 and that claims 2 and 18 are patentable over the references as cited by the Examiner.

**b. The Rejection Fails to Provide Proper Motivation For
Combining the Teachings of the Cited References**

In providing the required motivation for combining the *Oku et al.* and *Okada* references, the Examiner asserts it would have been obvious to one of ordinary skill in the art to modify the device in *Oku et al.* by the teachings of *Okada* in order to let the operator hold the camera easier when taking a picture and viewing the picture at the same time. Appellant maintains that this statement is insufficient in order to provide proper motivation under 35 U.S.C. § 103.

Assuming, *arguendo*, that *Okada* discloses the monitor extending to a part opposite the grip, the Examiner seeks to combine this teaching with the device of *Oku et al.* In support of this combination, the Examiner asserts it would allow the operator to hold the camera easier when taking a picture and viewing the picture at the same time. First, as the combination fails to suggest any different positioning of the hands of the operator, Appellant fails to understand how a mere arrangement of a monitor on the back of the camera would provide for letting the operator hold the camera easier when taking a picture and viewing the picture at the same time.

Additionally, if the monitor would extend to a part opposite the grip of *Okada*, the hand of the operator would extend to a portion over the monitor such that any image appearing in that portion of the monitor would be blocked by the operator's hand. As such, Appellant maintains that one of ordinary skill in the art would not look to the teachings of *Okada* to modify the device of *Oku et al.* As the Examiner has failed to provide proper motivation for the combination of the teachings of the cited references, Appellant maintains that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103.

c. **The Rejection of Dependent Claims 2 and 18 Relies On Impermissible Hindsight Reasoning**

By asserting that it would have been obvious to modify *Oku et al.* to include the features of *Okada*, with no suggestion or motivation in the applied references, or elsewhere to do so, the rejection appears to rely on impermissible hindsight reasoning. As such, Appellant maintains that dependent claim 2 is patentable over *Oku et al.* in view of *Okada*.

3. **The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 3**

Claim 3 depends indirectly from claim 1. Appellant submits that claim 3 is allowable for the reasons forth above in regard to claim 1 at least based upon its dependency on claim 1. Appellant further submits that dependent claim 3 is separately patentable and offers the following additional argument for the invention of claim 3.

The invention of claim 3 provides for the monitor being arranged such that a part of the second area and none of the first area are covered with the hand of the operator holding the camera by the grip in the recording mode.

In support of his rejection of claim 3, the Examiner asserts in Paper No. 20, page 6, paragraph 8, as follows:

Okada discloses the monitor is arranged such that a part of the second area and none of the first area are covered with the hand of the operating holding the camera by the grip in the recording mode (figure 2, LCD15, when it is considered as first area, is not covered by the hand of the operator holding the camera by the grip). *Oku et al.*, Figure 7c discloses the display area in VTR mode (a part of the second area) can be covered by the hand of an operator.

Appellant disagrees that *Okada* discloses that the monitor is arranged such that a part of the second area is covered with the hand of the operator holding the camera by the grip in the recording mode.

As discussed above with regard to claim 2, *Okada* fails to teach or suggest the monitor extending to a portion where the hand of the operator holding the camera by the grip would cover any portion of the monitor. As such, Appellant maintains that *Okada* fails to cure the deficiencies of *Oku et al.* as *Okada* fails to teach or suggest the monitor being arranged such that a part of the second area is covered with the hand of the operator holding the camera by the grip in the recording mode. As the cited references, either alone or in combination, fail to teach or suggest all of the claimed elements, in combination with the elements of intervening claim 2 and the elements of independent claim 1, assuming these references are combinable, which Appellant does not admit, the Appellant respectfully submits that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. As such, Appellant maintains that dependent claim 3 is allowable over the cited references.

4. **The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 4**

Claim 4 depends indirectly from claim 1. Appellant respectfully submits that claim 4 is allowable for the reasons set forth above with regard to claim 1, at least based upon its dependency on claim 1. Appellant further submits that dependent claim 4 is separately patentable and offers the following additional argument for the invention of claim 4.

As discussed above with regard to claim 3, neither of the reference, either alone or in combination, assuming these references are combinable, which Appellant does not admit, teach or suggest the monitor being arranged such that a part of the second area and none of the first area are covered with the hand of the operator holding the body to operate the camera in the recording mode. As the Examiner has failed to provide a reference that teaches or suggests all of the claimed elements as set forth in claim 4, in combination with the elements set forth independent claim 1, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a). As such, claim 4 is patentable over the cited references.

Additionally, in support of the Examiner's rejection of claim 4, the Examiner concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in *Oku et al.* by the teaching of *Okada* in order to let the operator view the whole image while taking pictures because the display is not covered by the hand of the operator. Appellant respectfully submits that this statement is insufficient in order to establish proper motivation to combine the teachings of the references.

First, as noted above, the combination of *Oku et al.* and *Okada* fails to teach or suggest a portion of the monitor being covered by a hand of the operator. Second, if a portion of the display was covered by the hand of the operator in the recording mode, then the Examiner's statement is incorrect as clearly a portion of the display would be covered by the hand of the operator and the whole image would not be visible to the operator. If the camera was in the

check mode, namely, a recording and a reproducing mode as disclosed in *Oku et al.*, then a portion of the playback signal would be covered by the hand of the operator. As such, again, the whole image would not be visible to the operator. As such, the Examiner's statement is incorrect and further fails to provide proper motivation to support the combination of the teachings of the cited references.

For all of the reasons set forth above, Appellant maintains that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. Appellant maintains that dependent claim 4 is patentable over the cited references.

5. **The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 13**

Claim 13 depends directly from claim 1. Appellant submits that claim 13 is allowable for the reasons set forth above with regard to claim 1 at least based upon its dependency on claim 1. Appellant further submits that dependent claim 1 is separately patentable and offers the following additional argument for the invention of claim 13.

The invention of claim 13 provides for the display including a third area wherein the third area is a marginal area on the display in which no image data appears and thereby provides a gripping area for the operator during the recording mode.

In support of his rejection of claim 13, the Examiner asserts in Paper No. 20, page 7, paragraph 8 as follows:

Oku et al. fail to specifically disclose the display includes a third area wherein the third area is a marginal area on the display in which no image data appears and thereby provides a gripping area for the operator during

the recording mode. However, Okada discloses a camera has a monitor (LCD 15), which includes rear cover 14 (third area), is arranged at a back of the body of the camera. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Oku et al. by the teaching of Okada in order to let the operator hold the camera easier when taking picture and viewing at the same time.

Appellant disagrees that *Okada* cures the deficiencies of *Oku et al.* as *Okada* fails to teach a third area on the display.

Okada clearly discloses LCD 15 and rear cover 14 being separate and not a part of the LCD 15, as disclosed in Figure 2. In contrast, claim 13 clearly recites the display including a third area. Appellant maintains that the rear cover of the camera does not properly incorporate the display and as such cannot constitute a third area of the display. As neither of the references teach or suggest all of the claimed elements, Appellant maintains that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103 by failing to provide references that teach or suggest all of the claimed elements. Appellant maintains that dependent claim 13 is patentable over the references as cited.

6. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 15 and 20

Claims 15 and 20 depend directly from claim 1. Appellant respectfully submits that claims 15 and 20 are allowable for the reasons set forth above with regard to claim 1 at least based upon its dependency on claim 1. Appellant further submits that dependent claims 15 and 20 are separately patentable and offers the following additional argument for the inventions of claims 15 and 20.

The invention of claim 15 provides for a back grip part at a side of the back of the camera which is held by a hand of the operator being made as a part of the display of the monitor, wherein the hand of the operator, during the recording mode, grips a part of the monitor. Claim 20 recites wherein a back grip at a side of the back of the camera which is held by a hand of the operator is made as a part of the display of the monitor, wherein a part of the monitor is covered by the base of a thumb of the operator gripping the camera in the recording mode and wherein at least one of a captured image or a preview image is displayed on a part of the monitor which is uncovered by the base of the thumb of the operator.

In support of his rejection of claim 15, the Examiner admits that *Oku et al.* fails to teach or suggest this claimed element. However, the Examiner asserts in Paper No. 20, page 7, paragraph 8 as follows:

Okada discloses a camera has a grip (figure 1) and monitor (LCD 15) is arranged at a back of the body of the camera and extends to a part opposite to the grip (figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in *Oku et al.* by the teaching of *Okada* in order to let the operator hold the camera easier when taking picture and viewing picture at the same time.

Appellant disagrees that *Okada* discloses wherein the hand of the operator during the recording mode grips a part of the monitor, as set forth in dependent claim 15.

As noted above with regard to claim 2, *Okada* fails to teach the monitor extending to a part opposite the grip. As the monitor fails to extend to a part opposite the grip, Appellant maintains that *Okada* fails to teach or suggest the hand of the operator during the recording mode

gripping a part of the monitor. Further, *Okada* fails to teach or suggest wherein a part of the monitor is covered by the base of a thumb of the operator gripping the camera in the recording mode and wherein at least one of a captured image or a preview image is displayed on a part of the monitor which is uncovered by the base of the thumb of the operator. As such, Appellant maintains that *Okada* fails to cure the deficiencies of the teachings of *Oku et al.*, assuming these references are combinable, which Appellant does not admit. As the Examiner has failed to provide references that teach or suggest all of the claimed elements, the Appellant maintains that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. As such, Appellant maintains that dependent claims 15 and 20 are allowable over the cited references.

7. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 16

Claim 16 depends indirectly from claim 1. Appellant respectfully submits that claim 16 is allowable for the reasons set forth above with regard to claim 1 at least based upon its dependency on claim 1. Appellant further submits that dependent claim 16 is separately patentable and offers the following additional argument for the invention of claim 16.

The invention of claim 16 recites wherein the camera during the recording mode does not display the captured image or the previewed image on a part of the monitor which corresponds to the back grip, a part of the display of the monitor that is covered by the hand.

In support of his rejection of claim 16, the Examiner asserts that *Oku et al.*, in Fig. 7, discloses the image captured in the recording mode is displayed in the center part and is not

displayed in the peripheral part which is used for the picture from the VTR, the VTR area can be covered by an operator's hand. Appellant disagrees that *Oku et al.* teaches this claim element.

As discussed above, *Oku et al.* discloses with regard to Fig. 7 a composite display which incorporates both the signal CV from the video camera and the signal PV from the VTR. As both of these are displayed simultaneously, assuming *Okada* discloses a portion of the monitor being covered by the hand of the operator, certainly at least a portion of the VTR image would be covered by the hand of the operator. As such, Appellant maintains that *Oku et al.* fails to teach this claim element. As *Okada* fails to cure the deficiencies of the teachings of *Oku et al.* by failing to teach this claim element, Appellant maintains that the Examiner has failed to establish *prima facie* obviousness by failing to provide a reference that teaches or suggests all of the claim elements. Appellant maintains that dependent claim 16 is allowable over the cited references.

8. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 17

Claim 17 depends directly from claim 1. Appellant respectfully submits that claim 17 is allowable for the reasons set forth above with regard to claim 1 at least based upon its dependency on claim 1. Appellant further submits that dependent claim 17 is separately patentable and offers the following additional argument for the invention of claim 17.

The invention of claim 17 recites wherein one of the strobe and a lens provided at the front face of the camera is covered by a hand of the operator to hold the camera in the reproducing mode, whereby gripping the back of the camera can be avoided and a reproduced image is displayed on a portion corresponding to a gripping portion of the monitor. In support of

the Examiner's rejection of claim 17, the Examiner asserts *Okada* discloses lens 18 provided at a front face of the camera and can be covered by a hand of the operator in viewing an image in playback mode. Appellant respectfully disagrees with the Examiner's characterization of this reference.

Appellant has noted above the teachings of *Okada*. The Examiner's mere reliance on Fig. 1 and lens 18 in support of his rejection of this claim is insufficient to satisfy his burden under 35 U.S.C. § 103. The claim clearly recites that gripping the back of the camera can be avoided and a reproduced image is displayed on a portion corresponding to a gripping portion of the monitor. As noted above, *Okada* fails to teach or suggest a gripping portion of a monitor. Further, there is no teaching or suggestion in *Okada* that is directed to how a user may hold the camera when reviewing images in the reproducing mode. *Okada* merely discloses a grip for the user to hold the grip when operating the camera. There is no teaching or suggestion in *Okada* that is directed toward holding the camera in any other fashion in the reproducing mode.

As neither of the references, either alone or in combination, teach or suggest all of the claim elements, Appellant maintains that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. As such, Appellant maintains that dependent claim 17 is allowable over the cited references.

9. **The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 21**

Independent claim 21 is directed to a camera comprising a selector for selecting one of a recording mode and a reproducing mode; a reproducing part for reproducing an image from the

recording medium in the reproducing mode; and a monitor arranged at a back of the body of the camera. When the camera is gripped in at least one of the recording mode, wherein a part of the back of the body of the camera is uncovered while a member which is necessary for picture taking is kept uncovered by a hand of the operator and, the reproducing mode, the back of the body of the camera is kept uncovered by the hand of the operator while a front of the body of the camera is covered, and wherein the monitor is arranged at such a position that a part of the monitor is covered by a hand of the operator if the camera is gripped in the recording mode whereas the entire area of the monitor is uncovered by the hand if the camera is gripped in the reproducing mode.

In support of his rejection of the claim, the Examiner admits that *Oku et al.* fails to specifically disclose the monitor being arranged in such a position that a part of the monitor is covered by a hand of the operator if the camera is gripped in the recording mode whereas the entire area of the monitor is uncovered by the hand if the camera is gripped in the reproducing mode. The Examiner relies on the teachings of *Okada* to cure the deficiencies of the teachings of *Oku et al.*, citing to Figs. 1 and 2. Appellant respectfully disagrees with the Examiner's characterization of this reference.

As noted above with regard to claim 2, *Okada* fails to teach or suggest the monitor arrangement as claimed. Further, as noted above with regard to claim 2, there is insufficient motivation for combining the teachings as asserted by the Examiner. As the Examiner has failed to teach or suggest the monitor arrangement as claimed, in combination with the other claim

elements as set forth in the claim, and further has failed to provide proper motivation for combining the teachings of the cited references, Appellant maintains that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. As such, Appellant respectfully submits that independent claim 21 is not obvious over the cited references.

10. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 22

Claim 22 depends directly from claim 21. Appellant respectfully submits that claim 22 is allowable for the reasons set forth above with regard to claim 21 at least based upon its dependency on claim 21. Appellant further submits that dependent claim 22 is separately patentable and offers the following additional argument for the invention of claim 22.

The invention of claim 22 provides for, *inter alia*, the camera further comprising a display controller to selectively switch between the first display mode and the second display mode in accordance with the selected gripping manner in the recording mode and the gripping manner in the reproducing mode.

In support of his rejection of claim 22, the Examiner asserts that *Oku et al.* teaches this claim element by asserting that the image captured in the recording mode is displayed in CAM area, and the playback image is displayed in the VTR area, citing to Fig. 7c. Appellant disagrees that these teachings are sufficient to teach or suggest the claim element.

Oku et al. clearly discloses that depending upon which mode the user selects, either the CV signal from the video camera is displayed or both the CV and the PV signals are displayed simultaneously.

In contrast, claim 22 clearly recites that the display controller selectively switches between the first display mode and the second display mode in accordance with the selected gripping manner in the recording mode and the gripping manner in the reproducing mode. There is no teaching or suggestion in *Oku et al.* that is directed to this claim element. Further, there is no teaching in *Okada* that is directed to this claim element. As neither of the references, either alone or in combination, teach or suggest all of the claim elements, Appellant maintains that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. As such, claim 22 is allowable over the references as cited.

11. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 23, 24, and 25

Claims 23-25 depend indirectly from claim 21. Appellant respectfully submits that claims 23-25 are allowable for the reasons set forth above with regard to claim 21 at least based upon its dependency on claim 21. Appellant further submits that dependent claims 23-25 are separately patentable and offers the following additional argument for the inventions of claims 23-25.

The rejection of claims 23-25 asserts that *Oku et al.* discloses the features as recited therein. However, Appellant submits that the rejection's reliance on *Oku et al.* fails to make up for the deficiencies of the rejection as applied in claim 21. As such, *Oku et al.*, taken alone or in combination with *Okada*, fails to establish *prima facie* obviousness of dependent claims 23-25.

12. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 26 and 27

Claims 26 and 27 each depend directly from claim 1. The rejection of these claims asserts that *Oku et al.* teaches the incremental features recited therein. Appellant respectfully submits, however, that the rejection's reliance on *Oku et al.* fails to cure the deficiencies of the rejection of claim 1. Thus, *Oku et al.*, taken alone or in combination with *Okada*, fails to establish *prima facie* obviousness of dependent claims 26 and 27.

C. Claims 6-8 and 12

The reasoning provided in support of the rejection of claims 6-8 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Oku et al.* in view of *Okada* fails to establish *prima facie* obviousness. Generally, the deficiencies of the rejection are that:

- a) the rejection attributes certain claimed features to the references that a detailed reading of the references reveals are not taught therein;
- b) when the nature and purpose of the device of *Oku et al.* is recognized, it is evident that there is no suggestion or motivation in either of the references cited in support of the rejection or in knowledge generally available to those skilled in the art to modify *Oku et al.* in a manner asserted by the rejection; and
- c) by asserting that certain modifications to the device of *Oku et al.* would have been obvious without a proper suggestion or motivation in the applied references or elsewhere to make the asserted modifications, the rejection appears to rely on impermissible hindsight reasoning.

Such deficiencies exist for the rejection for each of claims 6-8 and 12.

The legal requirements of *prima facie* obviousness have been set forth above in subsection B.

1. **The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 6**

Claim 6 depends directly from claim 1. Appellant submits that claim 6 is allowable for the reasons set forth above with regard to claim 1 at least based upon its dependency on claim 1. Appellant further submits that dependent claim 6 is separately patentable and offers the following additional argument for the invention of claim 6.

The invention of claim 6 provides for a camera including a touch panel arranged over the monitor, wherein an operational button is displayed on an area other than the first area on the monitor in the recording mode, so that the monitor and the touch panel serve as a camera operation part.

In support of his rejection of claim 6, the Examiner asserts in Paper No. 20, page 12, paragraph 9, as follows:

Oku et al. fails to specifically disclose a touch panel arranged over the monitor; and wherein an operational button is displayed on an area other than the first area on the monitor in the recording mode, so that the monitor and the touch panel serve as a camera operation part. However, Kawamura et al. disclose an electronic camera, which includes a touch panel (touch panel 2, figure 5, page 1, section [0022]); and operational button (buttons 25-27, figure 5) is displayed on an area other than the first area on the monitor in the recording mode (figure 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a touch panel as taught by Kawamura et al. in to the device in Oku et al. in order to provide an electronic camera has

capability of entering data by means of a pen-type designator (page 1, section [0006]).

Appellant disagrees that *Kawamura et al.* cures the deficiencies of the teachings of *Oku et al.*

The disclosure of *Kawamura et al.* is directed to an electronic camera having a pen input function. As can be seen in Fig. 9 and its related discussion in paragraph [0045], the electronic camera includes touch switches for effecting switching of various modes. In contrast, the present invention as set forth in claim 6 recites, *inter alia*, that an operational button is displayed on an area other than a first area on the monitor in the recording mode. *Kawamura et al.* teaches to utilize operational buttons 25-27 in order to select the mode. There is no teaching or suggestion that these operational buttons may be utilized in the recording mode. As *Kawamura et al.* fails to teach or suggest this claim element, *Kawamura et al.* fails to cure the deficiencies of the teachings of *Oku et al.*, assuming these references are combinable, which Appellant does not admit. As such, Appellant maintains that claim 6 is allowable over the references as cited.

2. The Rejection Fails to Establish *Prima facie* Obviousness of Dependent Claims 7, 8, and 12

Claims 7, 8, and 12 depend indirectly from claim 1. Appellant respectfully submits that claims 7, 8, and 12 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1. Appellant further submits that dependent claims 7, 8, and 12 are separately patentable and offers the following additional argument for the inventions of claims 7, 8, and 12.

The rejection of claims 7, 8, and 12 asserts that *Kawamura et al.* teaches the incremental features as cited therein. Appellant respectfully submits, however, that the rejection's reliance on *Kawamura et al.* as allegedly teaching this claim feature fails to make up for the deficiencies of the rejection as applied to claim 6 and, further, as applied to claim 1. Thus, *Kawamura et al.*, taken alone or in combination with *Oku et al.*, assuming these references are combinable, which Appellant does not admit, fails to establish *prima facie* obviousness of dependent claims 7, 8, and 12.

D. Claim 9

1. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 9

Claim 9 depends directly from claim 1. Appellant respectfully submits that claim 9 is allowable for the reasons set forth above with regard to claim 1 at least based upon its dependency on claim 1. Appellant further submits that dependent claim 9 is separately patentable and offers the following additional argument for the invention of claim 9.

The rejection of claim 9 asserts that *Furuya* teaches the incremental features as cited therein. Appellant submits, however, that the rejection's reliance on *Furuya* as allegedly teaching this incremental feature fails to make up for the deficiencies of the rejection applied to claim 1. Thus *Furuya*, taken alone or in combination with *Oku et al.*, assuming these references are combinable, which Appellant does not admit, fails to establish *prima facie* obviousness of dependent claim 9.

VIII. CONCLUSION

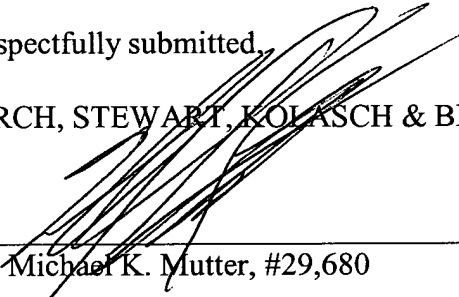
The withdrawal of the outstanding rejections and the allowance of claims 1-4, 6-9, and 12-27 is earnestly solicited.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

Date: October 3, 2005

By


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IX. CLAIMS APPENDIX

1. (Original) A camera comprising:

an imaging part for capturing an image of a subject;

a selector for selecting one of a recording mode and a reproducing mode;

a recording part for recording the image captured by the imaging part on a recording medium upon receiving a command to record in the recording mode;

a reproducing part for reproducing an image from the recording medium in the reproducing mode;

a monitor for displaying an image; and

a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode, and to display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode, the first area being smaller than the second area.

2. (Original) The camera as defined in claim 1, further comprising:

a grip to be held by a hand of an operator in the recording mode, the grip being arranged at a front of a body of the camera;

wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip.

3. (Previously Presented) The camera as defined in claim 2, wherein the monitor is arranged such that a part of the second area and none of the first area are covered with the hand of the operator holding the camera by the grip in the recording mode.

4. (Previously Presented) The camera as defined in claim 1, wherein the monitor is arranged on a body of the camera such that a part of the second area and none of the first area are covered with a hand of an operator holding the body to operate the camera in the recording mode.

5. (Original) The camera as defined in claim 1, further comprising:

a touch panel arranged over the monitor;

wherein, in the recording mode, the display controller determines an area on the monitor covered with a hand of an operator by the touch panel and bounds the first area on the monitor such that the first area excludes the covered area.

6. (Original) The camera as defined in claim 1, further comprising:

a touch panel arranged over the monitor;

wherein an operational button is displayed on an area other than the first area on the monitor in the recording mode, so that the monitor and the touch panel serve as a camera operation part.

7. (Original) The camera as defined in claim 6, wherein the operational button comprises at least one of a zoom operation button and an exposure correcting button.

8. (Original) The camera as defined in claim 1, further comprising:

a touch panel arranged over the monitor;

wherein at least one of an operational button for instructing the image reproduced on the monitor to be switched on a frame-by-frame basis in an order, an operational button for instructing the image reproduced on the monitor to be switched on a frame-by-frame basis in a reverse order, an operational button for instructing the image reproduced on the monitor to be enlarged, and an operational button for instructing the image reproduced on the monitor to be reduced, is displayed on the monitor in the reproducing mode.

9. (Original) The camera as defined in claim 1, wherein the monitor comprises a liquid crystal display.

10. (Original) A camera comprising:

an imaging part for capturing an image of a subject;

a monitor for displaying the image captured by the imaging part;

a touch panel arranged over the monitor; and

a display controller for determining, by the touch panel, an area on the monitor hidden by a matter touching the touch panel, and controlling the monitor to display the image on an area on the monitor excluding the hidden area.

11. (Original) The camera as defined in claim 10, further comprising:

a grip to be held by a hand of an operator, the grip being arranged at a front of a body of the camera;

wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip.

12. (Previously Presented) The camera as set forth in claim 1 wherein the first area is arranged to exclude an area covered with a hand of an operator holding a body of the camera to operate the camera to record the image.

13. (Previously Presented) The camera as set forth in claim 1, wherein the display includes a third area wherein the third area is a marginal area on the display in which no image data appears and thereby provides a gripping area for the operator during the recording mode.

14. (Previously Presented) The camera as set forth in claim 1, wherein the display controller changes a size of an image displayed on the monitor in accordance with switching between the recording mode and the reproducing mode by the mode selector.

15. (Previously Presented) The camera as set forth in claim 1, wherein a back grip part at a side of the back of the camera which is held by a hand of the operator is made as a part of the display of the monitor, wherein the hand of the operator, during the recording mode, grips a part of the monitor.

16. (Previously Presented) The camera as set forth in claim 15, wherein the camera during the recording mode does not display the captured image or the preview image on a part of the monitor which corresponds to the back grip part, the part of the display of the monitor that is covered by the operator's hand.

17. (Previously Presented) The camera as set forth in claim 1, wherein one of a strobe and a lens provided at the front face of the camera is covered by a hand of the operator to hold the camera in the reproducing mode, whereby gripping the back of the camera can be avoided and a reproduced image is displayed on a portion corresponding to a gripping portion of the monitor.

18. (Previously Presented) The camera as set forth in claim 1, wherein the monitor is arranged at the back of a body of the camera wherein a hand of the operator holding the camera extends to a portion of the monitor to cover the monitor by the hand of the operator in order to hold the camera for taking pictures.

19. (Previously Presented) The camera as set forth in claim 2, wherein the camera has a release button on the top face of the body of the camera, wherein the monitor, at a back of the body of the camera, extends to have a width which extends to at least interfere or cross over a line which is drawn vertically from the bottom of the release button to the bottom of the camera.

20. (Previously Presented) The camera as set forth in claim 1, wherein a back grip part at a side of the back of the camera which is held by a hand of the operator is made as a part of the display of the monitor, wherein a part of the monitor is covered by the base of a thumb of the operator gripping the camera in the recording mode and wherein at least one of a captured image or a preview image is displayed on a part of the monitor which is uncovered by the base of the thumb of the operator.

21. (Previously Presented) A camera comprising:
a selector for selecting one of a recording mode and a reproducing mode;

a reproducing part for reproducing an image from the recording medium in the reproducing mode; and

a monitor arranged at the back of the body of the camera,

wherein the camera is gripped, in at least one of the recording mode, wherein a part of the back of the body of the camera is covered while a member which is necessary for picture taking is kept uncovered by a hand of an operator and, the reproducing mode, the back of the body of the camera is kept uncovered by the hand of the operator while a front of the body of the camera is covered; and

wherein the monitor is arranged at such a position that a part of the monitor is covered by the hand of the operator if the camera is gripped in the recording mode whereas the entire area of the monitor is uncovered by the hand if the camera is gripped in the reproducing mode.

22. (Previously Presented) The camera as set forth in claim 21, wherein the camera has two display modes, wherein a first display mode displays an image in the first area of the monitor and a second mode displays an image in the second area of the monitor, an area of display in the monitor for the first area being smaller than the second area, and wherein the camera further comprises a display controller to selectively switch between the first display mode and the second display mode in accordance with the selected gripping manner in the recording mode and the gripping manner in the reproducing mode.

23. (Previously Presented) The camera as set forth in claim 21, wherein the camera switches the display of the monitor in response to the mode selector selecting one of the recording mode and the reproducing mode.

24. (Previously Presented) The camera as set forth in claim 21, wherein the camera includes a lens and a strobe as members necessary for picture taking on the front of the body of the camera.

25. (Previously Presented) The camera as set forth in claim 22, wherein the camera is adapted for the respective capturing and recording in response to the selecting of one of the first display mode while the camera is gripped in the recording mode and the second display mode while the camera is gripped in the reproducing mode.

26. (Previously Presented) The camera of claim 1, wherein the monitor displays the entirety of the image on the first area in the recording mode and the entirety of the image on the second area in the reproducing mode.

27. (Previously Presented) The camera of claim 1, wherein the display controller displays only the image captured by the imaging part on the monitor in the recording mode and displays only the image reproduced from the recording medium on the monitor in the reproducing mode.

X. EVIDENCE APPENDIX

No evidence has been submitted under 37 C.F.R. § 1.130, 1.131, or 1.132. No other evidence has been entered by the examiner and relied upon in this appeal.

XI. RELATED PROCEEDINGS APPENDIX

There are no related proceedings.



AF
JFW

Docket No.: 0879-0230P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Atsushi Misawa

Application No.: 09/286,906

Confirmation No.: 005582

Filed: April 6, 1999

Art Unit: 2612

For: CAMERA WITH MONITOR

Examiner: L. T. Nguyen

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed September 16, 2005, Applicant submits herewith a complete new Appeal Brief in compliance with 37 C.F.R. § 41.37 as follows:

The "Evidence Appendix" and "Related Proceedings Appendix" have been added.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinnet (Reg. No.52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No.: 09/286,906

Docket No.: 0879-0230P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: October 3, 2005

Respectfully submitted,

By 

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